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| 09/728,538 | 12/01/2000 | Peter B. Reintjes | P00044702 | 5338 |

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EXAMINER

CHANG, JON CARLTON

| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,538

Applicant(s)

REINTJES ET AL.

Examiner

Jon Chang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 4/1/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-13, 18-26 and 28-36 is/are allowed.
- 6) ☒ Claim(s) 1-3, 14-17 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Applicants' Amendment and Arguments

1. The amendment filed April 1, 2004, has been entered and made of record.

Claims 1-4, 14-18, 27, 28, 30 and 32 have been amended. Claims 4, 18 and 28 have been rewritten in independent form as suggested in the last Office Action. Claims 1-36 are pending.

Applicants' arguments have been fully considered. Contrary to Applicants' position (pages 20-21) (that Rom employs user-entered field location information as templates, rather than images) Rom does at least imply that the templates include images (note the form template has a "graphic layout", paragraph [0008], that an image of a form is matched with templates, paragraph [0024], and that a field is located **in relative correspondence** with data on the bitmap image, paragraph[0025]). However, the Examiner agrees that Rom does not provide enough disclosure to anticipate or render obvious the invention as is now claimed in claims 1-3, 14-17 and 27. The rejections relying on Rom are therefore withdrawn. The Examiner does wish to point out, however, that the invention as is now claimed in claims 1-3, 14-17 and 27 is not supported by the original disclosure. The Examiner wishes to point out also that portions of the original disclosure referred to by Applicants page 13, line 19 to page 15, line 17 describe two separate embodiments.

On page 19, in the paragraph beginning "Applicants have amended..." Applicants state that "the location information of the pen stroke data is compared with the bit image of the form." This argument is reiterated in the first full paragraph of page 21. This feature is not supported by the original disclosure. Rather, on page 13, at

lines 20-22, the specification states, "This bounding box may then be compared with boxes representing the fields of different forms to find the boxes that most closely match it." The Examiner notes that the only apparent comparison with a bit image of the form (i.e., template image) is at page 15, lines 10-17. However, while that portion of the specification describes comparing a bit map of user input data and bitmap of an empty form, there is no description of "location information of pen stroke data" being compared with the bit map. It is noted also that Applicants themselves differentiate location information from a bit map image (note first and second full paragraphs on page 21).

Claim Rejections - 35 USC § 112

2. Claims rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites, "means to detect pen stroke data...the location on the image of the form where the pen stroke data was entered..." is not supported by the original disclosure. The original disclosure does not describe pen stroke data being entered on an image of the form, but rather the original disclosure appears to describe that the pen stroke data is entered on the form itself. See also claim 15.

Claim 1 recites (emphasis added), "...selecting the best match of the **comparison** of the location information of the pen stroke data indicating the location on

the bit image of one of at least one form with the electronic bit image of the at least one form." This is not supported by the original disclosure for the following reasons.

1) Essentially, this language indicates that the matching is performed between a comparison and an electronic bit image. Note that the original claim indicated a matching between the pen stroke data and electronic images or forms.

2) The language refers to the "comparison of the location information...with the electronic bit image..." This feature is not supported by the original disclosure. Rather, on page 13, at lines 20-22, the specification states, "This bounding box may then be compared with boxes representing the fields of different forms to find the boxes that most closely match it." There does not appear to be support for the comparison of location information with an image.

3) Note also that the language now refers to the location of the pen stroke data on the bit image, and a match with the same bit image. (In other words, the claim does not distinguish between the image with the pen stroke data and the template image. They appear to be the same thing in the claim.). This is not supported by the original disclosure. Claim 15 suffers from similar problems.

3. Claims 1-3, 14-17 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, at lines 9-10, "...the location on the image of the form where the pen stroke data was entered..." renders the claim indefinite because previous to this, in the

claim, the pen stroke data is entered on the form itself, not on the image of the form.

Claim 15 suffers from the same problem.

Claims not mentioned specifically depend from indefinite antecedent claims.

Subject Matter not Found in the Prior Art

4. The subject matter of claims 1 and 15 have not been found in the prior art.

Allowability cannot be indicated for these claims because of the rejection under 35 U.S.C. § 112, first paragraph. Claims 2-3 and 14 depend from claim 1. Claims 16-17 and 27 depend from claim 15.

Allowable Subject Matter

5. Claims 4-13, 18-26 and 28-36 allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jon Chang
Primary Examiner
Art Unit 2623

Jon Chang
June 17, 2004